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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,427	02/11/2002	Srinivas Bette		9101

7590 12/04/2003
Srinivas Bette
5856 Bridle Bend Ct.
Plano, TX 75093

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,427

Applicant(s)

BETTE ET AL.

Examiner

James S McClellan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 2, 5, 6, and 8 are objected to because of the following informalities:

in claim 2, Applicant's use of a trademark (ORBD) is not allowed in the claim, wherein trademarks must be replaced with generic terminology;

in claim 5, line 1, the phrase "A software system of the above" fails to clearly set forth the dependency of the claim. If Applicant intends for claim 5 to depend from claim 4, the preamble of claim 5 should replace "A software system of above" with --The computer-based system of claim 4--;

in claim 6, the preamble fails to match the preamble of claim 5. The Examiner recommends replacing "An extension to the system in claim 5" with --The computer-based system of claim 5, further comprising an extension--;

in claim 8, line 1, the phrase "A computer-based method as defined above" fails to clearly set forth the dependency of the claim. If Applicant intends for claim 5 to depend from claim 4, the preamble of claim 5 should replace "A computer-based method as defined above" with --The computer-based method of claim 7--; and

in claim 8, each instance of the term "etc." should be deleted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6 are directed to both a process (method) and an apparatus (system). Since claims are only to be directed to either a process or an apparatus, it is unclear what Applicant intends to claim (i.e., claim 1 states, "A computer-based method and system"). In reference to each claim, Applicant must clearly set forth their desire to claim either a process or an apparatus. The examiner notes that claim 7 is clearly claiming a process (method).

In claim 2, line 12, it is unclear if Applicant intends to include positively claim the limitation "(technical and financial)" to further limit market data.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "a machine," but rather embraces or overlaps two different statutory classes of invention. See M.P.E.P. § 2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 3-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2001/0044768 A1 (Wares).

Wares discloses an Internet based computer system for integrating engineering design (see page 2, paragraph #0014) and procurement (see final line of ABSTRACT) that connects buyers, sellers, market places, content providers, and additional services (see Figure 1A and 1B). Additionally, Wares system improves cycle time and productivity using real-time data (see page 2, paragraph #0012 and page 5, paragraph #0071) and providing security measures (see page 5, paragraph #0086).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wares in view of U.S. Patent No. 4,257,718 (Rosa et al.).

Wares discloses all the limitations of claim 2, but fails to explicitly disclose the use of a computer to calculate pipe design.

Rosa et al. teaches the use of a computer to calculate pipe design (see ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wares with specific engineering design calculations for optimizing pipe designs as taught by Rosa et al., because utilizing pipe design calculations will help determine the an accurate estimate for a construction project.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wares in view of U.S. Patent No. 6,119,103 (Bausch et al.).

Wares discloses all the limitations of claim 8, but to explicitly disclose the use of risk calculations for decision making.

Bausch et al. teaches using historical data to predict financial risk (see column 3, lines 50-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wares with the risk prediction system taught by Bausch et al., because to help minimize adverse financial situations while optimizing the design.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

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Lesiten et al. is cited of interest for disclosing a system for a process and project management computer system.

Thackston is cited of interest for disclosing a collaborative system for the manufacture of parts.

Singer et al. is cited of interest for disclosing a web portal with data validation capabilities.

Buonanno et al. is cited of interest for disclosing a B2B transaction system utilizing an EDI system over the web.

Evans is cited of interest for disclosing a system for matching attributes and requirements.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

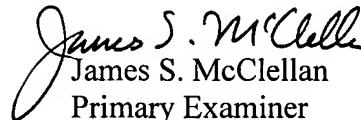
or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
November 26, 2003